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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,080	06/12/2001	Terry Guinan	P936 US	8025

7590 10/19/2004

IP Legal
Medtronic AVE, Inc.
3576 Unocal Place
Santa Rosa, CA 95403

EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,080

Applicant(s)

GUINAN ET AL.

Examiner

Kathryn Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to After-Final Amendment

1. This is a response to the After-Final Amendment dated August 20, 2004. Claims 1-5 are under consideration. The amendments to the specification and drawings are acknowledged.
2. The declaration filed on August 20, 2004 under 37 CFR 1.131 is sufficient to overcome the Duchamp reference.
3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. In light of the declaration, the finality of the previous office action is removed. However, although applicant has overcome the date of the Duchamp reference a new reference has been applied along with another Final Office Action.

Response to Arguments

4. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. in US Patent No. 5,324,259.

Regarding claim 1, Taylor et al. disclose a catheter assembly (generally at 10 and associated components) having an elongated tubular member (such as 12 and associated components) having a proximal end (generally at 31) and a distal end (generally at 23); a balloon (13) positioned at the distal end of the tubular member; an inflation lumen (21) extending through the elongated tubular member for providing inflation fluid for the balloon; a guidewire tubular member (via 12, 14 and 16) extending from a position proximal the balloon through the balloon formed of a first material (such as 12 and/or 14) having a first flexibility bonded to a distal segment formed of a second material (such as 14 and/or 16) different from the first material and having a second flexibility; and a bond joining the balloon distal end to the proximal segment and the distal segment, as recited in columns 5-7.

Regarding claim 4, Duchamp discloses that as applied to claim 1, as well as, an exit port (such as 23) proximal of a proximal end of the balloon, wherein the exit port provides access to the guidewire, as seen in figure 1.

Regarding claim 5, Duchamp discloses that as applied to claim 1, as well as, a second flexibility that is greater than the first flexibility, as recited in column 5, where the sealing element has greater flexibility.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. in US Patent No. 5,324,259.

Regarding claim 2, Taylor et al. disclose that as applied to claim 1.

However, Taylor et al. do not explicitly recite a first material that is a trilayer. On the other hand, trilayers are well known in the catheter art and there are numerous references that show trilayers. Thus, a trilayer is within the scope of that claimed and it would be obvious to one with ordinary skill in the art. Further, a high density polyethylene, binder layer and polyether-block co-polyamide polymer are also within the scope of the invention and obvious to one with ordinary skill in the art. In fact, on page 7 of the remarks section applicant states, "These chemical product names are known to those with ordinary skill in the art."

Regarding claim 3, Taylor et al. disclose that as applied to claim 1.

However, Taylor et al. do not explicitly recite a second material that is polyether-block co-polyamide polymer. However, a polyether-block co-polyamide polymer is within the scope of the invention and obvious to one with ordinary skill in the

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art. In fact, on page 7 of the remarks section applicant states, "These chemical product names are known to those with ordinary skill in the art."

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO



Henry Bennett
Supervisory Patent Examiner
Class. 3700